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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/321,386	05/27/1999	GREG BENSON	MEDIDNA.1C1C	6397

7590

01/30/2003

Frank Nguyen
Macrovision Corporation
2830 De La Cruz Boulevard
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EXAMINER

VON BUHR, MARIA N

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 01/30/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/321,386

Applicant(s)

BENSON ET AL.

Examiner

Maria N. Von Buhr

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/11/02, 7/30/02, 9/18/02 and 11/14/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/594,811.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12,13. 6) ☐ Other: _____

1. A request for continued examination under 37 CFR §1.114, including the fee set forth in 37 CFR §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR §1.114, and the fee set forth in 37 CFR §1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR §1.114.
2. This application is a continuation of Serial No. 09/164,606, which is itself a continuation of Serial No. 08/594,811 and is, therefore, accorded the benefit of the earlier filing date of January 31, 1996. Any previously presented rejections or objections which are not expressly repeated in this Office action are hereby withdrawn.
3. Acknowledgment is made of Applicant's claim for foreign priority under 35 U.S.C. §119 (a)-(d). The certified copy has been filed in parent Application No. 08/594,811, filed on January 31, 1996.
4. Examiner acknowledges receipt of Applicant's information disclosure statements, with accompanying reference copies, received January 11, 2002 and July 30, 2002, which have been taken into consideration for this Office action. Copies of the cited non-patent literature have not matched with the file. Therefore, Examiner was unable to consider these references, and requests that Applicant provide copies of the non-patent documents listed in Paper No. 13, received July 30, 2002, for consideration in the next Office action.
5. Examiner acknowledges receipt of Applicant's amendments, received September 18, 2002 and November 14, 2002; which introduce claims 54-95. Claims 1-95 are now pending in this application.
6. The indicated allowability of claims 1-53, as presented in Paper No. 10, mailed December 13, 2000, is withdrawn in view of the newly discovered reference to Sibert et al. A rejection based on the newly cited reference follows.
7. Claim 54 is rejected under 35 U.S.C. §135(b) as not being made prior to one year from the date on which the copied claim was actually patented. Applicant copies the instant claim from U.S. Patent No. 6,292,596 issued on September 18, 2001, and such copied claim was received in the Office on September

18, 2002. However, this copied claim substantially appears as claim 1 in U.S. Patent No. 6,157,721 issued on December 5, 2000, from which U.S. Patent No. 6,292,596 derives its priority. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632,1635 (Fed. Cir. 1997) where the Court held that the application of 35 U.S.C. §135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.

8. Claim 54 of this application has been copied by Applicant from U.S. Patent No. 6,292,569, granted September 18, 2001, to Shear et al. This claim is not patentable to Applicant because of the rejection above.

An interference cannot be initiated since a prerequisite for interference under 37 CFR §1.606 is that the claim be patentable to Applicant subject to a judgement in the interference.

9. The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 88-90 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, since the instant specification provides no disclosure concerning any IEEE standards.

11. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which Applicant regards as his invention.

12. Claims 66, 75, 84, 85 and 91-94 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. These claims are omnibus type claims.

13. Claims 64, 65, 76, 79, 80, 83 and 95 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim appears to be incomplete, since it is missing essential steps/means. Alternatively, the claim has been presented as a method/appliance comprised of a single step/means, which by analogy with a "single means" claim, presents ambiguity with regard to the metes and bounds of the claim, because the claimed method would appear to encompass any and all methods/means of securely communicating information. These appear to be omnibus type claims.

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-53 and 55-95 are rejected under 35 U.S.C. §102^a(b) as being clearly anticipated by the Sibert et al. article, entitled "DigiBox: A Self-Protecting Container for Information Commerce," published in 1995, see the whole document, but especially the abstract, which describes the DigiBox (TM) as "a cryptographically protected container for packaging information and controls that enforce information rights," and section 4, which describes the DigiBox (TM) as providing "a secure container to package information so that the information cannot be used except as provided by the rules and controls associated with the content. InterTrust rules and controls associated specify what types of content usage are permitted, as well as the consequences of usage such as reporting and payment ... as governed by arbitrarily flexible controls."

16. Claims 55-95 of this application have been copied by Applicant from U.S. Patent Application No. 08/848,077, now Publication No. 2001/0042043, filed May 15, 1997, and published September 18, 2001, to Shear et al. These claims are not patentable to Applicant because of the rejections above.

An interference cannot be initiated since a prerequisite for interference under 37 CFR §1.606 is that the claims be patentable to Applicant subject to a judgement in the interference.

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17. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.
18. Any response to this Office action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to the Office at:

(703) 746-7239 - for formal communications intended for entry, mark "FORMAL";
(703) 746-7240 - for informal/draft communications; label "PROPOSED" or "DRAFT".

Hand-delivered papers should be brought to Crystal Park II, 2121 Crystal Dr., Arlington, VA, 4th Floor (Receptionist).

19. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Maria N. Von Buhr whose telephone number is (703) 305-3837. The Examiner can normally be reached on Monday-Friday between 9:00 A.M. and 5:00 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Leo Picard can be reached at (703) 308-0538.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.



MARIA N. VON BUHR
PRIMARY PATENT EXAMINER
ART UNIT 2125

MNVB
1/24/03